

UNITED STATES COURT OF APPEALS FOR THE FEDERAL COURT

PAUL LEW and JASON SCHIERS,

Appellants,

v.

JOHN W. DUDAS, DIRECTOR OF THE  
UNITED STATES PATENT AND  
TRADEMARK OFFICE,

Appellee.

NOTICE OF APPEAL

Paul Lew and Jason Schiers hereby appeal the Court for review of the non-binding opinion issued by the Board of Patent Appeals and Interferences, Appeal No. 2006-2136, entered on November 29, 2006 and received on December 1, 2006, and which affirmed the Examiner's final rejection of Claim 19 of Application No. 10/658,143.



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The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

Ex parte PAUL LEW and JASON SCHIERS



Appeal No. 2006-2136  
Application No. 10/658,143  
Technology Center 3600

ON BRIEF

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Before FRANKFORT, LEVY, and FETTING, Administrative Patent Judges.  
LEVY, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claim 19<sup>1</sup>, which is the sole claim pending in this application.

We AFFIRM.

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<sup>1</sup> The Supplemental amendment filed November 8, 2004, which included claims 20-39, was denied entry by the examiner (answer, page 4), leaving only claim 19 before us for decision on appeal. We are not persuaded by appellants' assertion (brief, page 2) that "Applicants appeal the examiner's refusal to enter Applicants' Supplemental Amendment." As correctly noted by the examiner (answer, page 2) non-entry of an amendment is a petitionable matter under 37 CFR § 1.181 and is not subject to appeal. Accordingly, claims 20-39 are not properly before us for decision on appeal.

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BACKGROUND

The appellants' invention relates to a wheel hub with a clutch (specification, page 1).

19. A hub with clutch comprising:

- a) a hub body including a first sleeve and a second sleeve;
- b) the first sleeve includes an outer surface that includes a plurality of slots, wherein said slots are provided with a forward section, a tapered section, and an outwardly sloping surface extending from the forward section to the tapered section;
- c) the second sleeve includes a wall that includes a plurality of steps; and
- d) a plurality of curved members, wherein said curved members travel from the forward section along the outwardly sloping surface toward the tapered section, whereat the curved members contact the steps and transfer torque between the first sleeve and the second sleeve.

The prior art reference of record relied upon by the examiner in rejecting the appealed claims is:

Vogt

3,432,016

Mar. 11, 1969

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Claim 19 stands rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement<sup>2</sup>.

Claim 19 stands rejected under 35 U.S.C. § 102(e) as being anticipated by Vogt.

In addition, the examiner has objected to and denied entry of the substitute specification, where appellants have replaced "ball bearing(s)" with "curved member(s)".<sup>3</sup>

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejections, we make reference to the answer (mailed February 13, 2006) for the examiner's complete reasoning in support of the rejections, and to the brief (filed January 19, 2006) and reply brief (filed April 13, 2006) for the appellants' arguments thereagainst.

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<sup>2</sup> The rejection of claim 19 under 35 U.S.C. § 112, second paragraph, has been withdrawn by the examiner (answer, page 4).

<sup>3</sup> Although we do not usually review objections, as correctly noted by the examiner (answer, page 4), MPEP § 2163.06II states that "[i]f both the claims and specification contain new matter either directly or indirectly, and there has been both a rejection and an objection by the examiner, the issue becomes appealable and should not be decided by petition. Accordingly, in addition to considering the rejection of claim 19 under 35 U.S.C. § 112, first paragraph, we will also consider the examiner's objection to the substitute specification.

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Only those arguments actually made by appellants have been considered in this decision. Arguments which appellants could have made but chose not to make in the brief have not been considered. See 37 CFR § 41.37(c)(1)(vii)(eff. Sept. 13, 2004).

#### OPINION

In reaching our decision in this appeal, we have carefully considered the subject matter on appeal, the rejections advanced by the examiner, and the evidence of lack of written description and anticipation relied upon by the examiner as support for the rejections. We have, likewise, reviewed and taken into consideration, in reaching our decision, appellants' arguments set forth in the briefs along with the examiner's rationale in support of the rejections and arguments in rebuttal set forth in the examiner's answer.

Upon consideration of the record before us, we make the determinations which follow. We begin with the objection to the substitute specification and the rejection of claim 19 under 35 U.S.C. § 112, first paragraph as lacking written description. The examiner's position (answer, page 6) is that since the substitute specification only sets forth curved members, applicant is broadening the disclosure to include other members,

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which he did not show possession of at the time of filing. The examiner argues (answer, page 7) that "Applicant originally disclosed only 'ball bearings' throughout the entirety of [sic, the] original disclosure." The examiner asserts (id.) that on August 23, 2004, appellants filed an amendment that included a substitute specification, in which applicant replaced the ball bearings with curved members throughout the entirety of the original specification, and added new claim 19, in which applicant also introduced the phrase "curved member." The examiner maintains (id.) that "the newly introduced material 'curved member', in place of the originally disclosed 'ball bearing(s)', as presented in the substitute specification, has broadened the specification to include other types of bearings such as the tapered bearing, the cylindrical bearing, the sleeve bearing, and the roller bearing."

Appellants assert (brief, page 4) that "the substitute specification of August 23, 2004 simply made more explicit what was already inherently disclosed, and therefore, the substitute specification of August 23, 2004 did not introduce new matter into the specification. See M.P.E.P. § 2163.07(a)." It is argued (brief, page 6) that "the properties of the originally disclosed 'ball bearing' include having a curved outer surface."

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Consequently, Applicants' amendment, wherein 'ball bearing' was changed to 'curved member,' does not represent the introduction of prohibited new matter." In the reply brief, appellants argue (page 3) that there is nothing improper with amending the application to recite or claim an inherent function, theory, property or advantage, citing MPEP § 2163.07(a). It is argued (*id.*) that the examiner has confused the concept of breadth with the prohibition against introducing new matter or claiming subject matter in violation of the written description requirement.

To satisfy the written description requirement, a patent specification must describe the claimed invention in sufficient detail that one skilled in the art can reasonably conclude that the inventor had possession of the claimed invention. See, e.g., Moba, B.V. v. Diamond Automation, Inc., 325 F.3d 1306, 1319, 66 USPQ2d 1429, 1438 (Fed. Cir. 2003). The issue raised is most often phrased as whether the original application provides adequate support for the claims at issue or whether the material added to the specification incorporates "new matter" in violation of 35 U.S.C. § 132<sup>4</sup>. An applicant shows possession of the claimed invention by describing the claimed invention with all

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<sup>4</sup> MPEP § 2163.

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of its limitations. Most typically, the issue will arise in the context of determining whether new or amended claims are supported by the description of the invention in the application as filed. The proscription against introduction of new matter in a patent application serves to prevent an applicant from adding information that goes beyond the subject matter originally filed<sup>5</sup>. A ball bearing is defined as "a bearing in which the moving parts revolve or slide on freely rotating metal balls so that friction is reduced."<sup>6</sup> From the definition of a ball bearing, and the ball bearings disclosed in appellants originally filed specification, as illustrated in appellants originally filed drawings, we find that the ball bearings include a metal ball. A curve is "a line having no straight part."<sup>7</sup> From the definition of a curve as a line having no straight part, we find that the phrase "curved member" is much broader and far more encompassing than a "ball bearing," and that a "ball bearing" is a small subset of "curved members." We further find that not all curved members can carry out the claimed operation of the claimed

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<sup>5</sup> id.

<sup>6</sup> Webster's New World Dictionary, © 1972. A copy of the pertinent page is attached to this Decision.

<sup>7</sup> Webster's New World Dictionary, © 1972. A copy of the pertinent page is attached to this Decision.



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curved members? For example, a basketball, an M&M candy and the curved surface of a computer mouse can all be considered to be curved members, but are not capable of functioning as the curved members of appellants' claims.

From our review of the originally filed disclosure, we find that element(s) 59 are consistently referred to as "ball bearings." We find nothing in the originally filed disclosure that would have indicated to an artisan that anything other than a ball bearing could be used for this disclosed element. We additionally note that the specification also refers to the prior art as using ball bearings (pages 2 and 3). In the arguments provided, appellants have not pointed to any portion of the original disclosure that would have indicated to an artisan that element(s) 59 could be anything other than "ball bearings." Rather, appellants assert (brief, page 4) that "curved member" is inherent from the disclosure of "ball bearing."

While there is no *in haec verba* requirement, newly added claim limitations must be supported in the specification through express, implicit or inherent disclosure. To be inherent, the missing descriptive matter is necessarily present in the thing described, and would be so recognized by persons of ordinary skill. Appellants are correct (brief, page 6) that a ball

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bearing has a curved surface. However, there is no convincing evidence in the record that the limited disclosure in the specification of a ball bearing, without any indication that anything else could be used, would reasonably convey to an artisan that appellants had possession of the broader concept of any "curved member." That is, persons of ordinary skill in the art would not recognize in the disclosure a description of "curved members" as recited in claim 19 from the disclosure of "ball bearings."

Rather, we find that the "ball bearing" is a species of the larger, more encompassing genus of "curved member." The written description requirement for a claimed genus may be satisfied through sufficient description of a representative number of species. There may be situations where one species adequately supports a genus. "The disclosure of only one species encompassed within a genus adequately describes a claim directed to that genus only if the disclosure "indicates that the patentee has invented species sufficient to constitute the gen[us]." See Enzo Biochem, 323 F.3d 956, 966, 63 USPQ2d 1609, 1615 (Fed. Cir. 2002).<sup>8</sup>" In this instance, because we do not find from the originally filed disclosure any suggestion or teaching that

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<sup>8</sup> MPEP § 2163.05.

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anything other than a ball bearing can be used, and appellants have not pointed to any portion of the specification indicating or suggesting that the ball bearing(s) could be replaced with other structures, we are not convinced of any error on the part of the examiner in denying entry of the substitute specification or in rejecting claim 19 under 35 U.S.C. § 112, first paragraph. As stated, supra, ball bearing(s) are a small subset of curved member(s), and that not all curved members will function in place of the originally disclosed and claimed ball bearing(s). From all of the above, we find that appellants have impermissibly added new matter into the specification and claims. We hold that the examiner was correct in denying entry of the substitute specification. The rejection of claim 19 under 35 U.S.C. § 112, first paragraph is sustained.

We turn next to the rejection of claim 19 under 35 U.S.C. § 102(b) as being anticipated by Vogt. The examiner asserts, inter alia, that the first sleeve is met by element 1 of Vogt and that the second sleeve is met by the interior portion of element 8. Appellants assert (brief, page 8) that Vogt is directed to non-analogous art since the reference relates to a free wheel coupling device for timepieces. We are unpersuaded by

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appellants' argument regarding non-analogous art because the rejection is under 35 U.S.C. § 102.

Appellants further argue that claim 19 recites a hub body and that Vogt does not teach a hub body. From our review of the disclosure we find no specific definition of a hub body. Turning to a dictionary definition, we find that a hub is defined as "the center part of a wheel, etc., the part fastened to the axle, or turning on it."<sup>9</sup> From the definition of a hub, we agree with the examiner (answer, page 8) that the body 1 (figure 3) constitutes a hub since the body is fastened to axle 2 and turns on the axle.

Appellants additionally assert (reply brief, page 2) that Vogt does not support the examiner's finding of first and second sleeves. We agree. The specification does not provide a definition of a sleeve. Turning to a dictionary definition, we find that a sleeve is defined as "a tube or tubelike part fitting around or over or around another part."<sup>10</sup> From the definition of the term tube, we find that the flat, radially extending plates 1 and the inside of 8 of Vogt do not meet the claimed sleeves.

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<sup>9</sup> Webster's New World Dictionary © 1972. A copy of the pertinent page is attached to this Decision.

<sup>10</sup> Webster's New World Dictionary, © 1972. A copy of the pertinent page is attached to the Decision.

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Thus, although Vogt discloses the claimed clutch mechanism, Vogt does not anticipate claim 19 because Vogt does not teach the claimed first and second sleeves. Accordingly, we cannot sustain the rejection of claim 19 under 35 U.S.C. § 102 as being anticipated by Vogt.

#### CONCLUSION


To summarize, the decision of the examiner to reject claim 19 under 35 U.S.C. § 112, first paragraph is affirmed. The decision of the examiner to reject claim 19 under 35 U.S.C. § 102(b) is reversed.

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a)(1)(iv).

AFFIRMED

Charles E. Frankfort  
CHARLES E. FRANKFORT  
Administrative Patent Judge

  
STUART S. LEVY  
Administrative Patent Judge

) BOARD OF PATENT  
) APPEALS  
) AND  
) INTERFERENCES

  
ANTON W. FETTING  
Administrative Patent Judge

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